

Application Serial No. 09/345,668
Attorney Docket No.: 60027.0374USU1/BS98015

REMARKS

This Amendment is in response to the Office Action mailed February 14, 2006. Claims 1, 2, 5, 7, and 9-17 are pending in this application. Claims 1, 2, 5, 7, and 9-17 were rejected. Independent claims 1, 7, and 9-11 have been amended. New claim 18 has been added to provide a claim of varying scope than those initially filed. Applicants respectfully request reconsideration and examination in view of the amendments and remarks.

Substance of Interview Summary

A telephonic interview occurred between the undersigned, Murrell Blackburn and Examiner Dimitry Levitan on Wednesday, July 12, 2006. The interview covered the rejections to Claims 1, 2, 5, 7, and 9-17 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, and under 35 U.S.C. 103(a) as being unpatentable over Emery, U.S. Patent No. 6,011,975.

The Office Action states that network elements or components "operative to receive routing instructions including routing data from an SCP" and route the calls "based on the routing instructions received" were not described in the specification as filed. The undersigned pointed out to the Examiner that it is well known in the art that SCPs provide routing instructions and routing data so that other components can route calls. The undersigned also pointed out that the subject matter is described on page 12, lines 1-10 and Figure 3 and that an SCP is an AIN network element as described on page 3, lines 17-23 and in U. S. Patent 5,430,719 incorporated by reference. The Examiner stated that the specification does not associate an SCP as an AIN network element, but later conceded that U.S. Patent 5,430,719 can be used to support the undersigned's assertions of disclosure.

The undersigned again asserted that an SCP, as well known in the art, is by definition separate from a switch to make it easier to implement new services on an intelligent network and thus, does not perform the routing of the call. (See Newtons Telecom Dictionary, 17th edition, 2001). Thus, the communication element that routes the call can not possibly be an ISCP as disclosed in Emery. SCPs do not receive routing instructions and route calls. SCPs provide routing instructions so that other components can route calls.

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The undersigned also suggested an amendment reciting a wireless extension call to another wireless unit. The Examiner stated that such an amendment would likely be considered obvious considering the references. The Examiner indicated that he would examine the amendments and response upon receipt, but could not agree at the present time. Specifically, the Examiner indicated that the arguments made by the undersigned require further consideration and/or search. This written response is thus, submitted in follow-up to the telephonic interview for consideration by the Examiner, as it is believed to have placed the application in condition for allowance.

Claim Rejections – 35 USC § 112

Claims 1, 2, 5, 7, and 9-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 1, 2, 5, 7, and 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants assert that it is well known in the art that SCPs provide routing instructions and routing data so that other components can route calls. The subject matter is described on page 12, lines 1-10 and Figure 3 and on page 3, lines 17-23 in the specification and in U. S. Patent 5,430,719 incorporated by reference. Thus, Applicants respectfully submit that the claims contain subject matter which is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants also submit that the claims particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim Rejections – 35 USC § 103

Claims 1, 2, 5, 7, and 9-17 are rejected (as best understood) under 35 U.S.C. 103(a) as being unpatentable over Emery, U.S. Patent No. 6,011,975 (hereinafter Emery). Applicants

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respectfully submit that Emery does not teach or suggest each and every feature of Applicants' amended independent claims 1, 7, and 9-11.

Applicants' amended claim 1 is drawn to a system for including wireless units of a wireless network in a communications network so wireline units and the wireless units operating in the communications network may call each other by using wireline extensions or wireless extensions rather than by using wireline directory numbers or wireless numbers. The system comprises, among other features, (1) the communications element being operative to store the table, access the table to obtain the corresponding wireless number, receive routing instructions from a service control point (SCP), and the communications element routing the call pursuant to the corresponding wireless number based on the routing instructions received, and (2) the MSC of the wireless network being functionally connected to the communications element, the MSC serving at least one or more wireless units operating in the communications network, the MSC being operative to store the table, access the table to obtain, respectively, the corresponding wireless number or wireline directory number, receive routing instructions from the SCP, and based on the routing instructions received route the particular call pursuant to the corresponding wireless number or the corresponding wireline number. The communications element can be a public branch exchange (PBX), at least one end office of the wireline network serving the wireline units operating in the communications network, and/or the MSC.

As recited above, Applicants' claim 1 contemplates the communications element being a PBX, at least one end office, and/or an MSC of which all are capable of storing the table, receiving routing instructions from an SCP, and routing the call based on those routing instructions. In contrast, Emery only contemplates an ISCP storing information concerning a complete destination number. Thus, the ISCP of Emery cannot route calls but can only formulate response messages and must transmit the response messages back to an SSP (See Emery Col. 24, lines 59-62, Col 25, lines 43-46). Also because an ISCP is an SCP, Emery has no contemplated capability to receive routing instructions from an SCP as recited in amended claim 1. Because an ISCP cannot receive routing instructions from an SCP nor receive or route calls, nowhere in the reference does Emery teach or suggest a communications element capable of storing the table, accessing the table, receiving routing instructions from an SCP, and routing the calls based on those routing instructions. The Office Action attempts to assert that the STP 31

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operates as a service control point and cites column 12, lines 20-25 in support of the assertion. (See page 4, line 10 of Office Action). Applicants disagree and submit that the cited section only describes the STP operating as an STP as defined in an AIN not an SCP. Thus, Emery does not teach, disclose, or suggest amended claim 1.

The Office Action acknowledges that Emery does not teach storing the table at the MSC where the communication element comprises the MSC. (See page 3 of Office Action, 2nd to last paragraph). However, the Office Action also states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the communication element (ISCP 40 and STP 31) with the MSC in the system of Emery to improve the system connection setup time for the wireless customers if the majority of the Centrex Group are wireless." Applicants respectfully disagree and assert that Emery teaches away from the combining modification asserted by the Office Action. The Emery reference must be considered in its entirety including disclosures that teach away from the claims. The Emery reference explicitly states that the disclosed embodiment that utilizes the ISCP 40 is a preferred embodiment and that Fig. 2 is a detailed version of the best mode for carrying out the invention. (See Emery column 9, lines 53-54 and column 11, lines 3-6). Thus, the best mode contemplated by the inventors at the time of the invention included use on the ISCP 40 for sending response messages to an SSP in order for the SSP to route the call accordingly. All embodiments use the ISCP 40 and SSP for passing response messages (See Emery Col. 12, line 50- Col. 13, line 7; Col. 24, lines 59-62; Col 25, lines 43-46). Therefore, there is no evidence, suggestion, or motivation in Emery to modify Emery by combining the ISCP 40 and STP 31 with an MSC to improve connection setup time unless it is provided by Applicants' disclosure.

Even if Emery were to combine the ISCP 40 with an MSC, the ISCP 40 would still send a response message to an SSP. Thus, the MSC would not store and access the table and route the call as asserted in the Office Action. The ISCP 40 would store and access the table and send the response message to an SSP unless the ISCP undergoes a substantial reconstruction, redesign, and change in the basic principle under which Emery was designed to operate. Because, the proposed modification would change the principle of operation of Emery, then the teachings of Emery are not sufficient to render amended claim 1 obvious. The Office Action states that the Examiner believes that combining ISCP and STP with an MSC will not change the operation of

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the system. Applicants submit that even if the combination would not change the operation, the Examiner's belief can only be based on the Applicants' disclosure or impermissible hindsight. Thus, Emery teaches away from the asserted modification and there is no reasonable expectation of success. Therefore, the Office Action does not provide prima facie case of obviousness.

Applicants further submit that the Office Action has not satisfied MPEP §702.02(j). MPEP §702.02(j) requires that the prior art references teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and reasonable expectations of success must be found in the prior art and not based on Applicants' disclosure. Standard text within the telecom industry teaches away from the combination of the MSC with communication elements. A MSC is defined, by standard references, as a switch providing services and coordination between mobile users in a network. SCP and ISCP are defined, as a remote database within the System Signaling 7 network. The SCP supplies the translation and routing data needed to deliver advanced network services. The SCP is separated from the actual switch. Furthermore MPEP §2143.01(IV) citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) states "Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention." See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). At least because amended claims 1, 7, and 9-11 recite network elements receiving routing instructions from an SCP and routing the call based on the routing instructions received, claims 1, 7, and 9-11 are allowable over Emery.

In consideration of the above arguments, Applicant respectfully submits that claims 1, 7, 9, 10, and 11, even without amendment, are in condition for allowance.

Claim 2, 5, and 12-17

Regarding claims 2, 5, and 12-17, Applicant submits that claims 2, 5, and 12-17 are in condition for allowance by virtue of their dependency on amended claims 1, 7, 9, 10, and 11. MPEP §2143.03 citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, Applicant respectfully request reconsideration of the rejection to the claims 2, 5, and 12-17.

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Regarding the Examiner's response to previous arguments and additional assertions, which have not been addressed specifically, Applicant respectfully submits that these arguments are moot in view of the above comments and the amendment to the claims. Accordingly, in view of the above arguments, Applicants respectfully submit that claims 1, 2, 5, 7 and 9-17, even without amendment, are in condition for allowance.

CONCLUSION

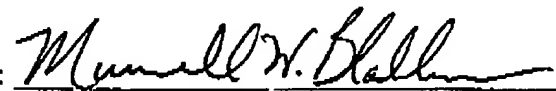
In view of the above amendments and remarks, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue and issue a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned please contact Applicants' undersigned attorney at 404.954.5041.

Respectfully submitted,

MERCHANT & GOULD, LLC

Date: July 14, 2006

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PATENT TRADEMARK OFFICE